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| 10/810,512   | 03/26/2004  | James R. Tighe       | 062891.1231                     | 1184                        |
| 5073   | 7590        | 10/08/2008           |                                 |                             |
| BAKER BOTTS L.L.P.<br>2001 ROSS AVENUE<br>SUITE 600<br>DALLAS, TX 75201-2980 |             |                      | EXAMINER<br>MOUTAOUAKIL, MOUNIR |                             |
|  |             |                      | ART UNIT<br>2419                | PAPER NUMBER                |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/810,512

**Applicant(s)**

TIGHE ET AL.

**Examiner**

MOUNIR MOUTAOUKIL

**Art Unit**

2619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 and 24-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 24-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-8, 10-17, 19-20, 22, and 24-26, and 33-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bales et al (US 5,574,724) in view of McAllister et al (US 2003/0048790). Hereinafter referred to as Bales and McAllister.

Regarding claims 1, 10, 35, and 39. Bales discloses a method for supporting communications. The method comprises establishing a packet-based audio communication link with a remote device (figure 1, 104 is interpreted as a remote device, column 3, lines 5-31, the audio communication link is established with the remote device); informing a local computing device of the audio communication link (column 3, lines 5-35, 101 connects to the communication link); receiving a message from the local computing device (column 3, lines 32-60, a messages is transmitted and received), the message requesting identification of enhanced media capabilities associated with the remote device (104 receives a message regarding media capability associated with it); receiving a response in the audio communication link from the remote device (column 3, lines 35-60. The system receives an acknowledgment regarding the transmitted request), the response identifying the enhanced media capabilities associated with the remote device (column 3, lines 35-60. An

acknowledgment is received regarding the media capability of 103); and forwarding the response to the local computing device (101 receives an acknowledgment regarding the transmitted message).

Bales discloses all the limitations of the claimed invention with the exception that the messages are tunneled in the audio communication link (118 and 119) to the remote device. However, McAllister, from the same field of endeavor discloses a method of tunneling messages between devices (see paragraph [0008]). Thus, it would have been obvious to a person of ordinary skill in the art at the time of the invention to employ the method of tunneling signaling messages, as taught by McAllister, for the purpose of privatization and reduce the amount of processing required during routing process.

Regarding claims 2, 11, and 36. Bales discloses a communication method, which further comprises determining, at the local computing device, whether the enhanced media capabilities associated with the remote device include a particular enhanced media capability; and communicating enhanced media packets to the remote device in response to determining that the enhanced media capabilities associated with the remote device include the particular enhanced media capability (column 3, lines 35-60. Based on the acknowledgment received, the system determines if the system may or may not support a video communication. If it may, the system initiates the video communication).

Regarding claims 3, 12, 24, 32 and 37. Bales discloses a communication method wherein the particular enhanced media capability is a video capability (column 3, lines 35-60. The media capability is a video capability), the enhanced media packets are

video packets (figure 1 is a packet switching network), and communicating the enhanced media packets to the remote device comprises tunneling the video packets in the audio communication link to the remote device (column 3, lines 62-67. Audio and video packets are transmitted through the same channel).

Regarding claims 4, 13, 25 and 38. Bales discloses a communication method wherein the particular enhanced media capability is a video capability (column 3, lines 35-60. The media capability is a video capability), the enhanced media packets are video packets (figure 1 is a packet switching network), and communicating the enhanced media packets to the remote device comprises communicating the video packets in a second communication link to the remote device (column 3, lines 62-67. the audio channel and video channel are different channels).

Regarding claims 5, 14 and 26. Bales disclose a communication method that further comprises receiving enhanced media packets from the remote device and automatically displaying (figure 1. 101 is connected to a displaying device 106 to display incoming video from the 104), at the computing device, at least one enhanced media window in response to receiving the enhanced media packets from the remote device (106 is interpreted as a displaying device. Inherently, Displaying a video will require the usage of a media window).

Regarding claims 6 and 15. Bales discloses a communication method wherein the particular enhanced media capability is an instant-messaging capability (column 3, lines 5-67. The media capability includes audio video capability. Audio video communication between at least two users is considered an instant messaging), the

enhanced media packets are instant-messaging packets (fig.1. The system is packet based system), and communicating the enhanced media packets to the remote device comprises tunneling the instant-messaging packets in the audio communication link to the remote device (column 3, lines 62-67. The audio video packets may be transmitted over the same channel).

Regarding claims 7 and 16. Bales discloses a communication method wherein the audio communication link uses Real-time Transport Protocol (RTP) (it is inherent that the system uses a Real-time transport protocol).

Regarding claims 8 and 17. Bales discloses a communication method that further comprises halting communications on the audio communication link; and informing the local computing device of the halting of communications on of the audio communication link (column 3, lines 5-32. the user establishes the communication link through 101. it is inherent for the user to stop the link established trough 101).

Regarding claims 19 and 22. Bales discloses a communication support apparatus. The apparatus comprises an interface operable to couple to a local computing device and a packet network (figure 1, 101 and 106); and a controller coupled to the interface (102), the controller operable to establish a packet-based audio communication link with a remote device (104), to inform the local computing device of the audio communication link (column 3, lines 5-32), to receive a message from the local computing device (column 3, lines 32-60, a messages is transmitted and received), the message requesting identification of enhanced media capabilities associated with the remote device(104 receives a message regarding media capability

associated with it), to tunnel the message in the audio communication link to the remote device (column 3, lines 35-60. the message is transmitter while the call is already established. Therefore, the message request must be tunneled), to receive a tunneled response in the audio communication link from the remote device column 3, lines 35-60. The system receives an acknowledgment regarding the transmitted request), the response identifying the enhanced media capabilities associated with the remote device (column 3, lines 35-60. An acknowledgment is received regarding the media capability of 103), and to forward the response to the local computing device (101 receives an acknowledgment regarding the transmitted message).

Regarding claim 20. Bales discloses an apparatus wherein the controller is further operable to tunnel enhanced media packets between the local computing device and the remote device in the audio communication link (column 3, lines 62-67 video packets are transmitted using a different channel or link).

Regarding claim 33. Bales discloses a system supporting communications. The system comprises a packet-based telephony device operable to establish an audio communication link with a remote device (fig.1); and a local computing device (104) coupled to the telephony device (103); wherein the telephony device is further operable to receive a tunneled message in the audio communication link from the remote device (101)(column 3, lines 32-60. 101 sends media capability request to 103), the message requesting identification of enhanced media capabilities associated with the local computing device (column 3, lines 32-60), to forward the message to the local computing device (figure 2, 203), to receive a response from the local computing device

(207, 208, 209), the response identifying the enhanced media capabilities associated with the local computing device (column 3, lines 32-60), and wherein the computing device is further operable to receive the message (203), to generate the response (207), to receive enhanced media packets from the remote device (207), and to automatically display at least one enhanced media window in response to receiving the enhanced media packets from the remote device (107, associated with 104, is a display device. 107 displays videos received from 101).

Bales discloses all the limitations of the claimed invention with the exception that the messages are tunneled in the audio communication link (118 and 119) to the remote device. However, McAllister, from the same field of endeavor discloses a method of tunneling messages between devices (see paragraph [0008]). Thus, it would have been obvious to a person of ordinary skill in the art at the time of the invention to employ the method of tunneling signaling messages, as taught by McAllister, for the purpose of privatization and reduce the amount of processing required during routing process.

Regarding claim 34. Bales discloses a system wherein the enhanced media packets are video packets and the enhanced media window displays video images (column 3, lines 32-60. 101 and 104 exchange video packets, and 107 displays videos received from 101)

3. Claims 27-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bales in view of Mukherjee et al (US 2004/0010614). Hereinafter referred to as Mukherjee.



Regarding claim 27 and 29. Bales discloses a method for supporting communications. The method comprises associating a packet-based telephony device (fig.1, 103) with a computing device (104); determining media capabilities associated with the packet-based telephony device (column 3, lines 5-60); determining enhanced media capabilities associated with the computing device (fig.2); Bales discloses that all the responses from the network elements are received separately and forwarded to element 101 (call manager).

Bales discloses all the limitations of the claimed invention with the exception that media capabilities of each element are aggregated into an aggregated set of media capabilities, and to communicate the aggregated set to a call manager (103, 202); and the call manager operable to associate the aggregated media capabilities with the packet-based telephony device. However, Mukherjee from the same field of endeavor discloses a method of communicating aggregated media capabilities of downstream media destinations and the system is capable of associate the aggregated media capabilities with each destination (see fig.9, and paragraph [0076]). Thus, it would have been obvious to a person of ordinary skill in the art at the time of the invention to aggregate the media capabilities of network elements, as taught by Mukherjee, for the purpose of saving network resources.

Regarding claim 28. Bales discloses a method that further comprises establishing an audio communication link between the telephony device and a remote device using the call manager (the communication link is established through 101-107),

the audio communication link supporting transmission of audio packets and embedded packets (column 3, lines 62-67. the audio link can embed video packets as well).

Regarding claim 30. Bales discloses a system wherein the call manager is further operable to establish an audio communication link between the telephony device and a remote device (column 3, lines 5-32 an audio link is established), the audio communication link supporting transmission of audio packets and embedded packets (column 3, lines 62-67. Video packets are embedded within an audio link).

Regarding claim 31. Bales discloses a system wherein the telephony device is further operable to tunnel a query in the audio communication link to the remote device (column 3, 32-62, fig 1, a query is sent to determine media capabilities of the remote device) the query requesting identification of a remote set of media capabilities associated with the remote device (column 3, lines 32-60), to receive a tunneled response to the query in the audio communication link (column 3, lines 32-60. an acknowledgment is received while an audio communication is established), the response identifying the remote set of media capabilities (column 3, lines 32-60. The response identify the media capabilities of the remote device), to forward the response to the computing device (column 3. lines 30-32. The acknowledgment is forwarded to the computing device); and the computing device is further operable to generate the query (101 generates the request), to receive the response, to determine whether the remote set of media capabilities includes a particular enhanced media capability (101 determines the media capabilities of the remote device), and to communicate enhanced media packets to the remote device in response to determining that the remote set of

media capabilities includes the particular enhanced media capability (video communication is established).

4. Claims 9, 18, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bales in view McAllister and further in view of Bowman-Amuah (US 6,434,568).

Bales discloses that halting communications on the audio communication link occurs after receiving an instruction from a user (column 3, lines 5-32. the user establishes the communication link through 101. it is inherent for the user to stop the link established through 101).

Bales does not disclose that the instruction selected from a plurality of options comprising hold, transfer, and mute. However, Bowman-Amuah discloses a method where the user has access to multiple instructions, such as holding, transferring, and muting (see column 61, lines 10-35). Thus, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to implement the method implementing phone features through a computer, as taught by Bowman-Amuah, into the communication terminal of Bales for the purpose of enhancing the capabilities and features of video conferencing or instant messaging.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO\_892.

Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific

limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

When responding to this office action, applicants are advised to clearly point out the patentable novelty which they think the claims present in view of the state of the art disclosed by the references cited or the objections made. Applicants must also show how the amendments avoid such references or objections. See 37C.F.R 1.111(c). In addition, applicants are advised to provide the examiner with the line numbers and pages numbers in the application and/or references cited to assist examiner in locating the appropriate paragraphs.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MOUNIR MOUTAOUAKIL whose telephone number is (571)270-1416. The examiner can normally be reached on Monday-Thursday (1pm-4:30pm) eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou can be reached on 571-272-3088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. M./  
Examiner, Art Unit 2619

/Hassan Kizou/  
Supervisory Patent Examiner, Art Unit 2619